

REMARKS

The Applicants appreciate the Examiner's careful consideration of their application and respectfully request reconsideration followed by allowance.

The Applicants have endeavored to re-write the Abstract of the Disclosure. Approval is respectfully requested.

The amended specification inserts references to sequences that are consistent with the sequences as identified in the Index attached to the Statement filed herein on July 30, 2001. Approval is respectfully requested.

In the alternative, Applicants endeavor to respond to the request for a substitute sequence listing. It is assumed that the Examiner was able to use the originally filed materials in view of the passing mention thereof in an attachment to the Office Action, and re-submission of the same materials does not presently seem necessary. (The relevant documents were filed herein on July 30, 2001 as seen from the post card supplied with the submission herein on May 28, 2003. The materials were filed by courier directly with the PTO *before* September 11, 2001.)

If Applicants' response to the Office Action with respect to the sequence listings is found wanting in any respect, please contact the undersigned.

Formal drawings are being separately filed. Approval is respectfully requested.

Amended claims 3, 4, 8, 9 and 10 are largely directed to matters of form. Alternative expressions such as "coding sequence" for "gene" are similarly viewed as not limiting the claim scope, and also obviate objections, including the matters noted in the Office Action in paragraph 11. Amended claims 8 and 9 also include language to moot the formality rejection in the Office Action, paragraph 13. The Examiner's suggestions are noted with appreciation. Amending claim 9 to change a "the" to an "a" is not seen as

limiting the claim scope. Claim 9 as amended recites non-human transformant. Please withdraw the objections/rejections predicated on matters of form.

The Examiner's objection to claims 1, 4 and 7 is noted. It is respectfully traversed. It is not seen that claim amendments need be considered until such time as the Examiner indicates allowable subject matter.

Applicants respectfully request reconsideration of the requirement for restriction. This file includes the ISR and IPER from the PCT stage and therefore the alleged burden of examining this application is substantially reduced. Furthermore, Applicants respectfully request re-joinder upon indication of allowable subject matter.

Applicants respectfully submit their specification satisfies the statutory requirements of 35 U.S.C. § 112(¶1). Please reconsider and withdraw the rejections of claim 1.

The Office Action unfortunately does not specify what passage in the "Guidelines" is germane to the statement "[t]his rejection is based on the Guidelines..." Applicants appreciate that an administrative agency is part of the Executive Branch of our government and such administrative agencies sometime provide "guidelines" as information to the public. Applicants do, however, respectfully acknowledge that the PTO is an administrative agency and its "Guidelines" remain subservient to the statutes as enacted by Congress. The "Guidelines" are no substitute for the statutory requirements of Title 35 United States Code. Please reconsider at least this grounds for the rejection and, if not withdrawn upon reconsideration, provide indication of the specific passages-grounds being cited from the "Guidelines."

Applicants' specification contains a written description of the invention in such a way as to reasonably convey to a person skilled in the art that the Applicants' had possession of their claimed inventions when their application was filed.

The specification does not need to recite *in hoc verba* claim language to comply with 35 U.S.C. §112(¶1) and the judicially interpreted (or construed) separate “written description requirement.”

The present specification describes the inventions to a person who is skilled in the art. Structural attributes common to members within the DNA of (b) in claim 1 are described. For instance, the specification describes at least three common attributes of a DNA as recited in (b), which include

- 1) a promoter function in a plant cell;
- 2) comprising a nucleotide sequence which has more than 90% identity to the nucleotide sequence of any region consisting of 250 bp or more with the nucleotide sequence shown in SEQ ID No:1 or SEQ ID No:7; and
- 3) comprising the nucleotide sequence in SEQ ID No:24.

In addition, since this specification is directed to a person who is skilled in the art, Applicants point out that a so-called TATA box is an element in a DNA to provide the promoter function in a plant cell. For instance, those skilled in the art would read the specification and understand that the so-called TATA box provides a DNA binding site for Transcription Factor II D in a plant cell. Given this understanding, a person who is skilled in the art would appreciate from the present specification that DNA described as having such promoter function would at least have in common a TATA box encoded therein. Accordingly, a person who is skilled in the art would recognize that Applicants were in possession of their inventions claimed herein at the time the application was filed.

Since the Office Action seems focused on the numbers of illustrative species described in the specification, it seems useful to address the actual description. For instance, the specification contains a written description of the DNA comprising the nucleotide sequence shown in SEQ ID No:1, as well as DNA comprising the nucleotide

sequence shown in SEQ ID No: 3, SEQ ID No:4, SEQ ID No:5, and, for example, SEQ ID No:7, all of which are within the scope of claim 1 (b). Therefore, Applicants' specification contains a written description of the inventions as claimed.

Furthermore, insofar as the rejection rests on written description, it is noted that the claims were part of the application as filed, and therefore from the standpoint of written description were part of the application. Clearly, Applicants showed they possessed their invention of claim 1.

As to claim 1, if the rejection under Section 112 is not withdrawn, a further non-final communication providing clarification as to the basis for the rejection is respectfully requested. The Office Action recites the rejection commencing at page 6 in terms of written description, but concludes with language known in the patent arts as relating to enablement at page 9. Applicants were not sure which was intended, although they have made a good faith effort to respond.

Applicants respectfully traverse the prior art rejection at pages 9 *et seq.* Claims 1 and 3-10 were rejected under 35 U.S.C. §102(e) over the Torikai et al. reference (U.S. Patent No. 5,959,176), assigned to Sumitomo Chemical Co., Ltd.

The present application is entitled to an effective priority date of October 2, 1998, has an assignee that is the same as the Torikai et al. reference, and in fact has common inventorship with the Torikai et al. reference. The Examiner will appreciate the inventor named Satomi Torikai, now following marriage, is known as Satomi Nishikawa. The person is obviously one and the same. Applicants can supply a Declaration to such effect upon request.

The Examiner is advised that an EP family member to the cited Torikai et al. U.S. patent is of record herein as part of an IDS filed on or about March 22, 2001. Upon present information and belief the EP family member (EP0824150) was published on February 18, 1998.

In any event, it will be appreciated that even if the Torikai et al. reference were prior art, it does not describe the subject matter of claim 1, including the attributes as noted previously herein. Accordingly, the promoter of claim 1 would not be anticipated by the Torikai et al. reference (or even its EP counterpart).

Applicants have endeavored to respond to all matters raised in the Office Action and respectfully submit their application is in condition to receive a notice of allowance.

Respectfully submitted,

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